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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,315	10/22/2001	Vladimir Hampl JR.	SMD-101-CIP	4388

7590

07/29/2003

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EXAMINER

LOPEZ, CARLOS N

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/037,315	HAMPL JR.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Carlos Lopez	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 12-14, 18, 19, 21, 23-26 and 28-36 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_ is/are allowed.

6) ☒ Claim(s) 12-14, 18, 19, 21, 23-26 and 28-36 is/are rejected.

7) ☐ Claim(s) \_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3/03.

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 12-14, 18-19, 21, 23-26, 28-30, 32, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hampl Jr. (US 5,730,840). Hampl discloses a cigarette wrapper having a basis weight range of 18gsm to 60 gsm, a permeability of 5 CU to 80 CU, calcium carbonate filler loading of 20% to 40% having a particle size in the range of .15 microns to .5 microns and an acetate burn control additive of .3% to 12% by weight (Columns 3- 4). Based on the additive content of Hampl (US 5,730,840), the fiber basis weight would be less than 18gsm based on the disclosed additive content of the cigarette paper in US 5,730,840 (Fiber basis weight= basis weight  $((1-\% \text{filler content})/100)$ ). In view that US 5,730,840 meets the claimed fiber basis weight, basis weight and filler particle size, the claimed opacity and tensile strength of the cigarette wrapper would be expected. Additionally, CO delivery that would result from the cigarette having the disclosed cigarette wrapper of Hampl, and claimed by Applicant, would be expected in view that the claimed structural limitations of the smoking article that would result when using Hampl's cigarette wrapper.

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2) Claims 12-14, 18, 19, 21, 23-26, and 28-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hampl Jr. (US 5,893,372). Hampl discloses a cigarette wrapper having a basis weight range of 18gsm to 60 gsm, a permeability of 5 CU to 80 CU, white pigment loading of 20% to 40% having a particle size in the range of .15 microns to .5 microns, an acetate burn control additive (Column 6), opacity at least 80%, and a brightness at least 70% (Columns 3, lines 23-25). Based on the additive content of Hampl (US 5, 893,372) and absent any additional additives, the claimed fiber basis weight would be less than 18gsm based on calculations of said disclosed additive content of the cigarette paper in US 5, 893,372. In view that US 5,893,372 meets the claimed fiber basis weight, basis weight and filler particle size, the claimed tensile strength of the cigarette wrapper would be expected. Additionally, CO delivery that would result from the cigarette having the disclosed cigarette wrapper of Hampl, and claimed by Applicant, would be expected in view that the claimed structural limitations of the smoking article that would result when using Hampl's cigarette wrapper.

As for claim 31 and 33, the term white pigment encompasses TiO<sub>2</sub> white pigment.

### ***Response to Arguments***

Applicant's arguments filed 6/2/03 have been fully considered but they are not persuasive. Applicant Argues that "For example, none of the above three-cited references disclose the discovery made by the present inventor that a paper wrapper having a relatively low fiber basis weight can be used to form a smoking article that delivers relatively low amounts of carbon monoxide and a desired carbon monoxide to tar ratio." Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically

pointing out how the language of the claims patentably distinguishes them from the references. Applicant's claims drawn to a smoking article whose structural limitations are met by the prior art's (more specific the structural limitations of the cigarette wrapper) would be expected to provide the claimed functions of CO delivery absent any other claimed structural feature of the smoking article. Furthermore, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Applicant's arguments with respect to inherency<sup>1</sup> it has been considered but are moot in view of the new ground(s) of rejection.

Additionally, applicant argues, "In the present case, Applicant submits that a low fiber basis weight paper will not always necessarily result in a smoking article having the carbon monoxide deliveries as now claimed. For this reason, Applicant submits that the claims as now amended patentably define over the prior art of record."

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<sup>1</sup> "Further, it is well settled that one of the criteria for determining whether a claimed element is inherently disclosed in a prior art reference is certainty. Inherency may not be established by probabilities or possibilities."

It is noted to Applicant that in page 17 lines 14-16 of applicant's specification, "The amount of fiber basis weight in a paper wrapper has a noticeable affect on the carbon dioxide delivery of a smoking article."

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
STEVEN P. GRIFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

C.L  
July 28, 2003